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REMARKS

To date, the Examiner has not indicated that all of the subject matter of the information disclosure statement (IDS) filed November 03, 2005 has been properly considered. A copy of such IDS is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the reference(s) is respectfully requested.

The Examiner has rejected Claim 57 under 35 U.S.C. 112, first and second paragraph, since "[i]t is unclear how an Internet connection can be opened if the Internet connection is non-functional." Applicant respectfully disagrees with such rejection, since nowhere in the claims or elsewhere is the Internet *itself* deemed to be non-functional.

The Examiner has further rejected Claims 1-12, 18-38 and 44-55 under 35 U.S.C. 103(a) as being unpatentable over Vaziri et al. (U.S. Patent No. 6,377,570) and further in view of Imai et al. (U.S. Patent No. 5,726,769). Applicant respectfully disagrees with such rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicants respectfully assert that at least the first and third elements of the *prima facie* case of obviousness have not been met.

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With respect to the first element of the *prima facie* case of obviousness, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vaziri in view of Imai in order to enable the use of indicators alerting the user that the passing of information is finished. Applicant respectfully disagrees with this proposition, especially in view of the vast evidence to the contrary.

For example, to support the motivation for such combination, the Examiner simply argues that "[o]ne would be motivated to do so in order to facilitate recognition of the completion of a specific task." It is noted from such statement, however, the Examiner fails to cite specific motivation in the above references to support the case for combining the same. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. *In re Regel*, 188 USPQ 132 (CCPA 1975). This is clearly absent in the Examiner's rejection.

More importantly, with respect to the third element of the *prima facie* case of obviousness, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of applicant's claimed "at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device" (see Claims 1 and 27) and "a user interface block to connect to said Internet-ready device" (see Claim 52).

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"Other than the user pressing a button (either on the ISB or
telephone keypad) to initiate the Internet telephone call, the
ISB takes care of all connection procedures (i.e., handshaking)
necessary to set up and maintain the Internet telephone call.
While both parties must possess an ISB in order to take advantage
of the ISB's IT capabilities, only one party needs to initiate
the telephone call in order to establish the Internet connection,
so that prearrangement is not required." (Col. 3, lines 33-37)

"FIG. 4 shows the back or bottom view of an ISB. Back or bottom
panel 402 can include telephone jack 404 for connection to
telephone 211, telephone jack 406 for connection to telephone
line 212, optional port (serial, parallel, universal serial bus
(USB), etc.) 408 for connection to another device such as a PC,
and power jack 410." (Col. 12, lines 1-6; see also Figure 4)
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Applicant respectfully asserts that the above excerpts from Vaziri simply relate to a telephone (item 211 of Figures 2B) that is not an "Internet-ready device," as claimed by applicant, since such device <u>cannot</u> connect to the Internet by itself.

In the last Office Action, the Examiner argues that 'Vaziri teaches "at least two connection ports (Fig. 4 shows the back or bottom view of an ISB - see Vaziri, Fig. 4, elements 406 and 408; col. 12, line 1), where the first port connects to an Internet conduit, and the second port connects to the Internet-ready device capable of communicating utilizing Internet-related protocols (Back or bottom panel can include telephone jack for connection to telephone line and optional port for connection to another device such as a PC - see Vaziri, col. 12, lines 1-6).'

Thus, it now appears that the Examiner is relying on the PC of Vaziri to make a prior art showing of applicant's claimed "Internet-ready device." Applicant respectfully asserts that, if the Examiner now relies on the PC of Vaziri to meet applicant's claimed "Internet-ready device," the remaining claim elements are simply not met.

For example, with respect to independent Claims 1 and 27, it is noted that there is no "protocol handler block for receiving and handling messages from" .... Vaziri's PC, and "for sending on said handled messages to a network stack block," as specifically required by applicant's claims. Still yet, there is no "user interface, allowing a user to initiate passing information between said" Vaziri's PC "and said Internet," as claimed. Further, with respect to Claim 52, there is no apparatus, as claimed, "embedded" in Vaziri's PC, as claimed.

This deficiency is rooted, at least in part, in the fact that Vaziri discloses that the "port 408 can be used for any operation involving an exchange of data between the ISB and some other device, such as programming and testing the ISB at the factory and for attachment to some peripheral such as a digital camera for videophone service or a caller ID unit." This functionality vastly departs from the functionality and structure supporting

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Vaziri's telephone, that the Examiner relies on to meet applicant's other limitations associated with the claimed "Internet-enabled device."

In reviewing the Examiner's rejection, it appears that the Examiner is attempting to rely a first Vaziri feature (e.g. PC, etc.) to meet a claim element (e.g. Internet-ready device, etc.) in a first context in the claims, and then uses structure/functionality associated with a second different, non-Internet-enabled device from Vaziri (e.g. telephone 211, etc.) to meet the same claim elements in a different context (as noted above). Applicant asserts that such use of Vaziri as a dictionary in this manner is simply inappropriate, and is further evidence that the prior art of record simply does not meet applicant's claims.

With additional reference to independent Claims 1 and 27, the Examiner has adjusted his rejection to now rely on the following excerpt from Vaziri to make a prior art showing of applicant's claimed "protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device" (see this or similar, but not identical language in each of the foregoing claims).

"Checking and sending messages will now be explained with reference to FIGS. 7D and 7E. To check messages, the user dials #3 to enter message checking through the menu. The ISB connects to the ISP and then connects through ISP 706 and Internet 712 to POP server 716. Once this last connection is achieved, the ISB downloads and plays the first message. The user can then dial 1 to repeat, 2 to go to the next message or 3 to erase a message, much as he would with an answering machine. To send a message, the user dials #4, whereupon the ISB connects to the ISP and then connects through ISP 706 and Internet 712 to SMTP server 718 (the function of the SMTP server having been described above). The user can then record a message and then send it via the SMTP server to the recipient's e-mail address. The ISB can be configured to impose a time limit on outgoing messages (e.g., 60 seconds). The ISB can also be configured to poll the ISP periodically (e.g., four times a day or some other interval which is either set in the factory or programmed by the user) to check for message and to give an indication to the user via an LED or the like when messages are waiting.

The ISB can also be configured to poll the ISP periodically (e.g., four times a day or some other interval which is either set in the factory or programmed by the user), whenever a call is completed over IP, or both to check for message and to give an

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indication to the user via an LED or the like when messages are
waiting. In one configuration, polling takes place only when all
three of the following conditions are satisfied: (1) the polling
period set in the ISB has expired, (2) the telephone has not been
in use in the last two minutes and (3) no ring signal has been
received in the last two minutes. Of course, the ISB can be
equipped with an internal clock, such as those used in
conventional IBM-compatible PCs, to allow periodic polling.

Each voice mail message is stored on the recipient's POP server
in the form of an e-mail message with the sender's e-mail address
listed in the "From:" field, a standard subject such as "ISB
voice mail message" and a MIME attachment of the voice mail
message in an appropriate sound file format. If the recipient
checks his e-mail on the POP server with a conventional e-mail
program such as Eudora, he will see such message interspersed
among conventional e-mail messages. The ISB can distinguish the
voice mail messages from the conventional e-mail messages by the
subject." (Col. 17, line 57 - col. 18, line 33)

Applicant respectfully asserts that the above excerpt from Vaziri only relates to
messages from a telephone, not an "Internet-enabled device," as claimed (again, note that
the Examiner now relies on Vaziri's PC to meet applicant's claimed "Internet-enabled
device"). Further, the messages of the above excerpt do not relate to messages from a
"user interface" of an "apparatus for a user to connect an Internet-ready device to the
Internet," as claimed. Thus, in no way is there even a suggestion of any sort of "protocol
handler block for receiving and handling messages from said user interface and from said
Internet-ready device," in the manner claimed by applicant.

With additional reference to independent Claims 1 and 27, the Examiner has
relied on the following excerpt from Vaziri to make a prior art showing of applicant's
claimed protocol handler block for receiving and handling messages from said user
interface and from said Internet-ready device, and for "sending on said handled messages
to a network stack block" (see this or similar, but not identical language in each of the
foregoing claims).

"More specifically, the ISB stores device, server, billing, and
owner information and a friends directory. The device information
is typically programmed into the ISB at the factory and includes
the serial number, the manufacturing date, the hardware version,
the software version, and the feature key, which identifies those
features which the ISB implements. The server information
includes the IP addresses for the various servers which the ISB

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> needs to access, such as the primary and backup ISBSSs. The owner
> information includes the telephone number, the ISP access
> telephone number, any scripting required to log onto the ISP,
> logon name and password, the domain names or IP addresses for the
> SMTP and POP servers for e-mail, the e-mail address, and the e-
> mail password." (Col. 13, lines 13-25)

Applicant respectfully asserts that the above excerpt from Vaziri only relates to information with respect to the device, server, billing, owner information and friends directory that the Internet switch box (ISB) stores. Further, by virtue of the above arguments, there is not even a suggestion of any sort of messages, let alone sending handled messages from said user interface and from said Internet-ready device to a network stack block, in the manner claimed by applicant.

Applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met, for at least the reasons noted above. A notice of allowance or a specific prior art showing of each of the foregoing claimed features, in combination with the remaining claimed features, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NVIDP322_P001314).

Respectfully submitted,
Zilka-Kotab, PC.

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COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:)
)   Group Art Unit: 2155
        Johnson et al.   )
)   Examiner: Baturay, Alicia
Application No.: 10/049,972   )
)   Atty. Docket No.: NVIDP322/
Filed: February 13, 2002   )   P001314
)
For: INTERNET JACK   )   Date: November 3, 2005
)
)
_____)

INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §§ 1.56 AND 1.97(c)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The reference(s) listed in the attached PTO Form 1449, cop(ies) of which is attached
(when necessary), may be material to examination of the above-identified patent application.
Applicants submit the reference(s) in compliance with their duty of disclosure pursuant to 37
CFR §§ 1.56 and 1.97. The Examiner is requested to make the reference(s) of official record in
this application.

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This Information Disclosure Statement is not to be construed as a representation that a search has been made, that additional information material to the examination of this application does not exist, or that the reference(s) indeed constitutes prior art.

This Information Disclosure Statement is being filed after the mailing date of a first Office Action. Accordingly, applicants are including payment in the amount of $180.00 for the fee due in connection with the filing of this Information Disclosure Statement. However, if it is determined that any additional fees are due, the Commissioner is hereby authorized to charge such fees or credit any overpayment to Deposit Account 50-1351 (Order No. NVIDP322).

Respectfully submitted,
Zilka-Kotab, PC

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Form 1449 (Modified)	Atty. Docket No. NVIDP322/P001314	Application No.: 10/049,972
Information Disclosure **Statement By Applicant** (Use Several Sheets if Necessary)	Applicant: Johnson et al. Filing Date: February 13, 2002	Group Art Unit: 2155

U.S. Patent Documents

Examiner Initial	No.	Patent No.	Date	Patentee	Class	Sub-class	Filing Date
	A						
	B						
	C						
	D						
	E						
	F						
	G						
	H						
	I						
	J						
	K						

Foreign Patent or Published Foreign Patent Application

Examiner Initial	No.	Document No.	Publication Date	Country or Patent Office	Class	Sub-class	Translation Yes	No
	L	01/013583A3	02/22/2001	WIPO	H04L	12/28	X	
	M	99/39488	08/05/1999	WIPO	H04L	29/08	X	
	N	99/65219	12/16/1999	WIPO	H04M	11/06	X	
	O							
	P							

Other Documents

Examiner Initial	No.	Author, Title, Date, Place (e.g. Journal) of Publication
	R	Margolin, Bob, "Smarter Stuff" http://www.byte.com/art/9706/sec6/art2.htm , June 1997
	S	Panian et al. "The IP Modem Interface Standard: Draft" Portable Computer Communications Association, Brookdale, CA., January 11, 1999
	T	
Examiner		Date Considered

Examiner: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Pg. 1 of 1